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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,513	08/06/2002	Peter Brossart	WWELL52.001APC	8680
20995	7590	08/05/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			UNGAR, SUSAN NMN	
			ART UNIT	PAPER NUMBER
			1642	

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

94.

Office Action Summary

Application No.

10/019,513

Applicant(s)

BROSSART ET AL.

Examiner

Susan Ungar

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1 and 13-34 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14 and 16-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/16/01, 2/19/02</u> . | 6) <input type="checkbox"/> Other: _____ |

1. The Election filed July 12, 2004 in response to the Office Action of June 9, 2004 is acknowledged and has been entered. Claims 11-12 have been canceled and claims 1, 15, 21, 24, 27-30 have been amended. Claims 1, 13-34 are pending in the application and Claims 13-14, 16-34 have been withdrawn from further consideration by the examiner under 37 CFR 1.142(b) as being drawn to non-elected inventions. Claims 1 and 15 are currently under prosecution.
2. Applicant's election with traverse of Group 1, claims 1 and 15 in the paper submitted July 12, 2004 is acknowledged. The traversal is on the ground(s) that the amendment of all of the pending claims to recite dependence upon claim 1 obviates the restriction requirement since all of the claims share the special technical feature of claim 1, Applicants request that the restriction requirement be withdrawn. The argument has been considered but has not been found persuasive. The claims were properly restricted under PCT practice because it was found that technical feature linking the inventions of the groups does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the art for the reasons of record. For this reason the restriction requirement is deemed to be proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by WO92/07000.

The claims are drawn to an isolated peptide consisting essentially of SEQ ID NO:1 (claim 1), a pharmaceutical composition comprising the isolated peptide of claim 1 (claim 15).

It is noted that claim 1 of WO92/0700 is loosely translated as a pharmaceutical composition for treating or preventing a malignant tumor which comprises a therapeutic agent, a polypeptide known to bind to H23 in association with a pharmaceutical diluent. It is further noted that SEQ ID NO:2 of the reference binds to H23 (see p. 19).

It is noted that the phrase “consists essentially of” is interpreted by the Office, for examination purposes, as open language and carries the same meaning as the term “comprises” (see MPEP 2111.03).

WO92/07000 teaches an isolated peptide comprising SEQ ID NO:1 of the instant invention (see pages 19-22) and a pharmaceutical composition comprising said isolated peptide (see claim 1). All of the limitations of the claims are met.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1 and 15 are rejected under 35 USC 112, first paragraph, as the specification does not contain a written description of the claimed invention. The

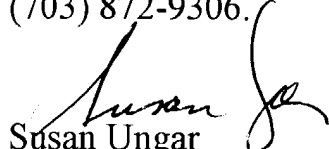
limitation of "consists essentially of" recited in newly amended claim 1 has no clear support in the specification and the claims as originally filed. A review of the specification did not disclose support for the phrase and Applicant has not pointed to support for the phrase in the specification or claims as originally filed. The subject matter claimed in claims 1 and 15 broadens the scope of the invention as originally disclosed in the specification.

7. No claims allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (571) 272-0837. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at 571-272-0787. The fax phone number for this Art Unit is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 872-9306.


Susan Ungar
Primary Patent Examiner
August 2, 2004